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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/710,334 | 07/01/2004 | David S. Bonalle | 70655.3100 | 4333 |
| 20322 | 7590 | 09/30/2005 | EXAMINER | |
| SNELL & WILMER ONE ARIZONA CENTER 400 EAST VAN BUREN PHOENIX, AZ 850040001 | | | WALSH, DANIEL I | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2876 | |

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/710,334

Applicant(s)

BONALLE ET AL.

Examiner

Daniel I. Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the Amendment received on 12 July 2005.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-5 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black (US 2005/0122209).

Re claim 1, Black teaches a method for registering biometric information for use in a smartcard system, the method comprising: detecting a proffered biometric at a sensor to obtain a proffered biometric sample; verifying the proffered biometric sample; storing the proffered

biometric sample; and associating the proffered biometric sample with a smartcard such that the smartcard system utilizes the proffered biometric sample to authorize a smartcard payment utilizing the smartcard (FIG. 5A, paragraphs [0016, 0028, 0030-0046, and 0083]. The Examiner notes the card can have an associated account/value that is used to make payment for the transaction. As the card and sample is used for a purchase/financial transaction, it is interpreted to include associating it with a smartcard for transactions. Though Black is silent to storing on a database, the Examiner notes that databases are well known and conventional means for storing and organizing stored data. It would have been obvious to use a database to store the data in an efficient and organized way for retrieval.

Re claim 2, the Examiner notes that detection/associating/processing of the sample is a part of detecting/sensing/receiving the sample.

Re claim 3, the Examiner notes that as the samples are stored in a user file/computer/on the transponder/card itself, it is interpreted as logging (paragraph [0027], for example).

Re claim 4, Black teaches detecting/associating/processing one additional proffered biometric sample, through the capture of the signature (FIG. 5A).

Re claim 5, FIG. 5A teaches determining if the fingerprint is legible. This is interpreted as one of processing, comparing and verifying the sample.

Re claim 9, it has been discussed above re claim 5, to verify a sample. Though silent to specifically using a local CPU/third party vendor to do so, the Examiner notes it would have been obvious to use a local CPU/third party to do so, as a well known and conventional means to process data for verification.

Re claim 10, though Black is silent to using a secondary security procedure to verify the sample, the Examiner notes that such means are well known and conventional in the art (body heat measurement, blood flow, etc.), and one would have been motivated to use such a procedure to ensure only legitimate samples are accepted (reduce fraud, for example).

Re claim 11, as discussed above the sample can be stored locally or remotely. Though silent to a database, it would have been obvious to use a database as a means to organize and store data for retrieval.

3. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black in view of Robinson (as cited in the previous Office Action).

Re claims 6-8, the teachings of Black have been discussed above.

Black is silent to verifying including comparing a proffered biometric sample with a stored biometric sample (one of a criminal, terrorist, and cardmember).

Robinson teaches a system for biometric authorization for transaction processes. Specifically, Robinson teaches that during the enrollment process, customer data (interpreted to include biometric data), is compared to a data already registered in the central database for uniqueness (paragraph [0057]). Accordingly, this is interpreted as comparing a proffered biometric with a stored biometric. The Examiner notes that the stored biometric can be one of a criminal, terrorist, or cardmember, since the comparison is performed to reduce multiple enrollments or reduce fraud/alert fraudulent enrollments. Re claim 8, Robinson teaches the customer data is compared to that on central database 204.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Robinson.

One would have been motivated to do this in order to increase security.

Additional Remarks

4. O’Gorman et al. (US 2003/0123714) teaches also using body heat/blood flow to verify a finger of a fingerprint as a living finger.

Conclusion

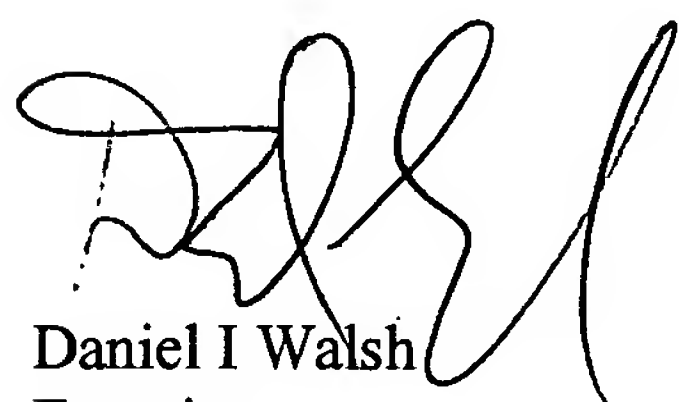
5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel I Walsh
Examiner
Art Unit 2876
9-24-05



KARL D. FRECH
PRIMARY EXAMINER